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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,426	12/12/2003	Marion Heinz	12251	2304

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,426

Applicant(s)

HEINZ ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 8-15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 22, 2007 has been entered.
2. The rejection of claims 1-16 under 35 USC 112, first and second paragraphs, with respect to the issue, "essentially compact", set forth within paragraphs 1 and 2 of the Office action of February 22, 2007 has been withdrawn in view of applicants' remarks and amendments. In addition to the citations within specification, specified by applicants, for providing support for the amendments, the disclosure at page 3, lines 5-8 of the specification additionally provides support for the amendments.
3. Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 11-14, Component bv) is not mutually exclusive from Components biii) or biv); specifically Component bv) overlaps Components biii) and biv), in terms of functionality and molecular weight. As drafted, a single specific reactant will satisfy the requirements of multiple components; accordingly, one of ordinary skill could not clearly determine the metes and bounds of the claim, since one could not determine if multiple components, though overlapping, are required. Applicants' response of May 22, 2007 has not addressed this issue with respect to Components biii), biv), and bv). The position is ultimately taken that to define

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the components as claimed introduces a degree of ambiguity into the claims that renders the claims indefinite.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartz et al. (US 2001/0051261).

Bartz et al. disclose compact polyurethanes produced from polyisocyanates which may be higher than difunctional (note the use of p-MDI and mixtures thereof within paragraph [0025]) and polyol components that meet those claimed. Applicants' components bi), bii), and biii) are met by the reference's component b13). In view of the reference's use of the plural terminology, "polyether alcohols", the position is taken that the reference's component b13) encompasses mixtures of such polyols. This position is further bolstered by the fact that the reference's components b11) and b12) are referred to in the singular. Applicants' component biv) are met by the reference's component b11). Applicants' component bv) is met by the reference's component b12). See paragraphs [0001] through [0029], [0031], and [0034].

6. Applicants' arguments have been considered; however, they are insufficient to overcome the prior art rejection. Firstly, despite applicants' arguments, as aforementioned, the position is taken that the reference's component b13) encompasses mixtures, and it is of no import that instant components bi) and bii) are mutually exclusive; they are still met by the reference's component b13). Secondly, applicants have argued that the reference fails to disclose applicants'

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polyol components with sufficient specificity to anticipate the claims. In response, given that the reference encompasses a mixture of polyols b13), that applicants' various polyols continue to meet the disclosed polyols, and that quantities of polyols are claimed that overlap those disclosed, the position is taken that the teachings of the reference is adequate to anticipate the claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
June 16, 2007


RADON SERGENT
PRIMARY EXAMINER